

**REMARKS**

Claims 1, 5-13, 15-17, 33, 48-49 are currently amended. Claims 3-4, 14, 18-32 and 34-47 are not changed or amended.

Claim 2 is cancelled.

New claims 53-65 are added.

Accordingly, claims 1 and 3-65 are pending in the application. Applicants respectfully request reconsideration in view of the present amendment and remarks. Applicants respectfully submit that this amendment is in compliance with 37 CFR § 1.116, and request entry of this amendment and a notice of allowance for the pending claims.

While there is a discrepancy between the Office Action and form PTOL-326, it appears that claims 3-4, 14, 18-32 and 34-47 are allowed. These claims will not be discussed further herein.

Claims 5-13 and 15-17 are amended to depend from allowed claim 3. Claims 8, 10 and 13 are further amended to more clearly refer to the coating layer. Applicants submit that because claims 5-13 and 15-17 depend from allowed claim 3, they are allowable. A withdrawal of the rejection and a notice of allowance for claims 5-13 and 15-17 are respectfully requested.

New claims 53-65 are added, and depend from allowed claim 14. Applicants submit that because claims 53-65 depend from allowed claim 14, they are allowable. A notice of allowance for claims 53-65 is respectfully requested.

**Rejections under 35 USC § 102(b).**

Claims 1, 6-13, 17, 33 and 48-52 were rejected under 35 USC § 102(b) as being anticipated by Walker. The Office Action states the following on page 2:

"Walker et al. teach EVA emulsions used for adhesives. The EVA emulsions are made in the presence of a surfactant and 1-5% polyvinyl alcohol. These materials are used as coatings so they meet the limitations regarding coated articles. Coating a substrate with the materials would meet the claim limitations related to making the material more hydrophilic. Walker et al. teach that the adhesive is used in packaging applications such as "vinyl laminating". This is interpreted as laminating a *vinyl* (a type of polymer) film." (citations omitted, emphasis added).

Claims 1, 7-13, 15, 17, and 48-52 were rejected under 35 USC § 102(b) as being anticipated by Freidzon. The Office Action states the following in the paragraph bridging pages 2-3:

“Friedzon teaches coatings comprising EVA polymerized in the presence of polyvinyl alcohol and a surfactant. These coatings comprising additional additives such as de-foamers. Coating a substrate with the materials would meet the claim limitations related to making the materials more hydrophilic. The US patent teaches that the adhesives are used to bind polymeric materials (*vinyl*), in the production of laminates.” (citations omitted, emphasis added).

According to the Office Action, Walker et al. and Freidzon disclose the use of adhesive on a *vinyl* substrate or laminate.

Independent claims 1, 33, 48 and 49 have been amended to recite that “the base layer is formed from polycarbonate film, polyacryl film, polymethacryl film, styrenic polymer film, polyester film, or a co-polymer film formed from one or more of the polymers used in making the foregoing polymer films”. Support for these amendments can be found in the specification at page 4, lines 11-14.

Because the Office Action states the prior art references disclose a vinyl laminate, and because the polymer film as defined in amended claims 1, 33, 48 and 49 is not a vinyl laminate, the prior art references do not anticipate claims 1, 33, 48 and 49. Applicants respectfully request that the rejection under 35 USC § 102(b) to claims 1, 33, 48 and 49, and to claims 50-52 that depend from allowable claim 49, be withdrawn, and that a notice of allowance for claims 1, 33, and 48-52 be provided.

Rejections under 35 USC § 103(a).

Claims 1, 2, 5-13, 15-17, 33, and 48-52 were rejected under 35 USC § 103(a) as being unpatentable over Walker. Claims 1, 2, 5, 7-13, 15-17 and 48-52 were rejected under 35 USC § 103(a) as being unpatentable over Freidzon. The rejections are respectfully traversed.

The Office Action states, with reference to claim 2, the following:

"The references above teach emulsions which can be used as coatings on substrates. Claim 2 encompasses a wide range of polymeric films. It would have been obvious to one having ordinary skill in the art to have used the coating emulsions taught by Freidzon *for coating plastic films in general* since EVA has adhesive properties." (Paragraph bridging pages 3-4, emphasis added)

Claims 1, 33, and 48-49, as amended, specify that "the base layer is formed from polycarbonate film, polyacryl film, polymethacryl film, styrenic polymer film, polyester film, or a co-polymer film formed from one or more of the polymers used to make the foregoing polymer films." With reference to the amended independent claims, the cited prior art references do not disclose the defined features, do not suggest that one of ordinary skill would have a reasonable expectation of success in using such films, and do not suggest or motivate one to modify the prior art to use "plastic films in general" as suggested in the Office Action, and do not suggest or motivate the use of the polymer films as defined in claims 1, 33 and 48-49 in particular.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The references, alone and in combination, fail to disclose or suggest the polymer films of the base layer as defined in independent claims 1, 33 and 48-49. Particularly, the Office Action states that the film disclosed by the references is a vinyl laminate. Disclosure of vinyl laminate is not disclosure of a polycarbonate film, polyacryl film, polymethacryl film, styrenic polymer film, polyester film, or a co-polymer film formed from one or more of the

polymers used in making the foregoing polymer films, and is not a suggestion to use such a film. This fails the first requirement to make a *prima facie* case of obviousness.

The references fail to suggest or motivate one of ordinary skill to modify the disclosure of the prior art references to instead use the polymer films of the base layer as defined in the pending claims. Particularly, the Office Action identifies no motivation to use a base layer formed from polycarbonate film, polyacryl film, polymethacryl film, styrenic polymer film, polyester film, or a co-polymer film formed from one or more of the polymers used in making the foregoing polymer films, in place of the disclosed vinyl laminate. This fails the next requirement to make a *prima facie* case of obviousness.

Further still, the references fail to suggest that one would have a reasonable expectation of success in making the proposed substitution for the vinyl laminate. The Office Action states that it would have been obvious "for coating plastic films in general since EVA has adhesive properties." This amounts to the use of an impermissible "obvious to try" standard. This fails the last requirement to make a *prima facie* case of obviousness.

Accordingly, the Office Action fails to make a *prima facie* case of obviousness having failed to meet any of the three requirements to form a *prima facie* case of obviousness. Applicants respectfully submit that the rejection under 35 USC § 103(a) should be withdrawn and request that a notice of allowance be issued for claims 1, 33 and 48-49. Applicants respectfully request also that a notice of allowance be issued for claims 50-52 that depend from allowable claim 49, and are thus also allowable.

### **Conclusion**

Applicants respectfully request that this amendment be entered, and a notice of allowance issued for the currently pending claims. In the alternative, Applicants request entry of the amendment for purposes of an appeal. If it is determined that unresolved issues remain, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the application.

Application No. 10/712,978  
Reply to Office Action of November 17, 2004

In the event any additional fees are due in connection with the filing of this paper, the Commissioner is authorized to charge those fees to our Deposit Account No. 18-0988 (Reference: AVERP3423USB).

Respectfully submitted,  
RENNER, OTTO, BOISSELLE & SKLAR, LLP

By



---

Neil A. DuChez, Reg. No. 26,725

1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115  
(216) 621-1113  
Customer No. 48556